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PATENT

**REMARKS**

Please do not enter the amendment and response inadvertently filed in this matter on August 6, 2004, and substitute therefore, the present amendment.

Claims 1-20 were pending in this application.

Claims 1-20 have been rejected.

Claims 1-11 and 16 have been amended as shown above.

Claims 2, 7, 12 and 17 have been canceled.

New Claims 21-24 have been added.

Claims 1, 3-6, 8-11, 13-16 and 18-24 are now pending in this application.

Reconsideration and full allowance of Claims 1, 3-6, 8-11, 13-16 and 18-24 are respectfully requested.

**I. OBJECTIONS TO THE DRAWINGS**

The Office Action lists several objections to the drawings. First, in paragraph 2 of the Office Action, the drawings were objected to under 37 CFR 1.83(a) as not showing every feature of the invention specified in the claims. Specifically, the features "sort system," "primary sort key," "secondary sort key," "audio/video receiver" and "signal" were requested to be shown in the drawings or canceled from the claims. The Applicant has proposed to amend Figure 1 to show the "primary sort key" (reference number 115), "secondary sort key" (reference number 116), "sort keys" (reference number 117) and "signal" (reference number 114). The Applicant

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has further amended the specification to include reference numbers 114, 115, 116 and 117. In addition, the Applicant has amended Claims 1-5 to replace the feature "sort system" with the feature "system" and Claims 6-10 to replace the feature "audio/video receiver" with "receiver." The feature "system" is shown in Figure 1A and 1B as reference number 100, and the feature "receiver" is shown in Figure 1A as reference number 110 or 111.

Second, in paragraph 3 of the Office Action, the drawings were objected to for lacking textual labels for the following elements: 100, 101, 200, 201, 202, 210, 211, 212, 220 and 221. This objection is respectfully traversed. The Examiner did not provide, and the Applicant is unaware of, any rule requiring textual labels in the Figures. However, Applicant does note that reference number 100 refers to a system, now clearly pointed to in Figures 1A and 1B, reference number 101 points to a box containing the textual label "Controller," reference number 200 points to a user interface display (for example, a screen shot on a computer screen) that should not need a textual label as it is easily recognizable, reference number 201 points to a button with the textual label "Find TV," reference number 202 points to a listing of programs, each having a separate textual label, reference number 210 also points to a user interface display, reference number 211 points to a button with the textual label "Find Songs," reference number 212 points to a listing of programs, each having a separate textual label, reference number 220 also points to a user interface display and reference number 221 points to a slider containing textual information.

Third, in paragraph 4 of the Office Action, the drawings were objected to for failing to comply with 37 CFR 1.84(p)(4) because the reference character "201" was used to designate the

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user control element in both Figures 2A and 2C. This objection is respectfully traversed. 37 CFR 1.84(p)(4) requires that the "same part of an invention appearing in more than one view of the drawing must always be designated by the same reference character." Applicants respectfully submits that reference character 201 is used to designate the same user control element in both Figures 2A and 2C. For example, on page 11, lines 6-10, the present application states: "FIGURES 2A through 2C are mockups of a user interface display for content reception system controller ... according to one embodiment of the present invention." As a result, Applicants are required to use the same reference character 201 to designate the user control element in Figures 2A and 2C.

Fourth, in paragraph 5 of the Office Action, the drawings were objected to for failing to comply with 37 CFR 1.84(p)(4) because the reference character "202" was used to designate the listing in both Figures 2A and 2C. This objection is respectfully traversed. Applicants respectfully submit that reference character 202 is used to designate the same listing in both Figures 2A and 2C, which can be easily determined from comparing the listings. In addition, on page 16, lines 14-16, the present application states: "FIGURE 2C depicts a user interface 220 including a 'slider' user control 221 enabling a user to navigate the sorted listing 202." As a result, Applicants are required to use the same reference character 202 to designate the listing in Figures 2A and 2C.

Fifth, in paragraph 6 of the Office Action, the drawings were objected to due to the partial views in Figure 1. The Applicants have proposed to amend Figure 1 to label each partial view separately with different Figure designations. Specifically, the top view is now labeled

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Figure 1A and the bottom view is now labeled Figure 1B, in accordance with the Examiner's suggestion.

Accordingly, the Applicants respectfully request the Examiner to withdraw the objections to the drawings.

## **II. OBJECTIONS TO THE SPECIFICATION**

The Office Action objects to the specification as not providing appropriate serial numbers for each of the cross-referenced applications on page 1 of the specification. The Applicants have amended page 1 of the specification to provide the appropriate serial numbers, as the Examiner suggested. Accordingly, the Applicants respectfully request the Examiner withdraw the objection to the specification.

## **III. REJECTIONS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH**

The Office Action rejects Claims 1-20 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Office Action states that the following limitations do not appear to be described properly in the specification: "current user task context and content type," "sort keys," "primary sort key," "secondary sort key," "audio/video receiver" and "signal." These rejections are respectfully traversed.

Applicants respectfully submit that the feature "current user task context" is described throughout the specification, and particularly on page 11, lines 13-23; page 12, lines 1-3; page 12, lines 9-12; page 15, lines 1-7; page 14, lines 14-22; and page 18, lines 1-5. For example, on

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page 11, lines 14-23, the present application states: "Searches may be performed for different purposes or in different manners. For example, user searches may be performed either to record, to playback from previous recording, or to contemporaneously view, or with a desire find a specific item rather than to browse available content. Depending on the task which the user is attempting to complete, the system may utilize the task context to automatically select primary, secondary, and other (e.g., tertiary) sort keys for ordering the results list." Thus, the feature "current user task context" is sufficiently described in the specification.

Applicants respectfully submit that the feature "content type" is described throughout the specification, and particularly on page 14, line 23 – page 15, line 21, where the application states: "In the present invention, the sort keys are also dependent on the content type being searched, with different sort key combinations being set by default for the system, or derived from user histories, for specific content types. User interface display 210 in FIGURE 2B includes a user control 211 for searching for currently available audio content. ... The system may anticipate sort orders preferred by most people for different content types (e.g., video, songs, books, etc.) in default sort keys or sort key combinations, of, in the learning process, create separate rules within a user profile for each content type and user task context." Thus, the feature "content type" is sufficiently described in the specification.

Applicants respectfully submit that the feature "sort keys" is described throughout the specification, and particularly on page 2, lines 9-16 and page 14, lines 1-13. For example, page 2, lines 10-13 of the present application state: "For example, within entertainment systems users can often sort lists of content by title, genre, time of day, channel, actors, directors, or even by

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recommendation or rating." Thus, the feature "sort keys" is sufficiently described in the specification.

Applicants respectfully submit that the features "primary sort key" and "secondary sort key" are described throughout the specification, and particularly on page 10, line 20 – page 11, line 1; page 12, line 1 – page 14, line 22. For example, page 11, lines 19-23 of the present application states: "Depending on the task..., the system may utilize the user task context to automatically select primary, secondary, and other (e.g., tertiary) sort keys for ordering the results list." In addition, page 12, lines 3-8 of the present application state: "... the system may automatically sort results based on recommendation rating (primary sort key) and ... alphabetically by title (secondary sort key), the ordering which would most effectively help the user." Furthermore, page 13, lines 7-15 of the present application state: "Intuitive and natural secondary and lower-order sort keys are selected based on context, content type, and user preferences.... Heuristics or rules may be defined for selecting the primary, secondary and/or lower-order sort keys, or default sort keys may be simply set and/or modified by the user." Thus, the features "primary sort key" and "secondary sort key" are sufficiently described in the specification.

The feature "audio/video" receiver has been amended in the claims to now recite "receiver." Applicants respectfully submit that the feature "receiver" is shown in Figure 1A as reference number 110 or 111, and described throughout the specification, and particularly on page 7, line 14 – page 12, line 12. Thus, the feature "receiver" is sufficiently described in the specification.

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Applicants respectfully submit that the feature "signal" is shown in Figure 1B as reference number 114, and described throughout the specification, and particularly on page 8, lines 13-23. Thus, the feature "signal" is sufficiently described in the specification.

Accordingly, the Applicants respectfully request the Examiner withdraw the 35 U.S.C. § 112, first paragraph rejection of the claims.

**IV. REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

The Office Action rejects Claims 1-20 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Office Action considers the following limitations in Claim 1 (and other claims) vague: "current user task context and content type" and "sort keys." In addition, the Office Action considers the following limitations in Claims 3, 8, 13 and 17 vague: "primary sort key" and "secondary sort key." These rejections are respectfully traversed.

As described above in section III, the features "current user task context," "content type," "sort keys," "primary sort key" and "secondary sort key" are sufficiently described in the specification, and as a result are not vague. Accordingly, the Applicants respectfully request the Examiner withdraw the 35 U.S.C. § 112, second paragraph rejection of the claims.

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V. REJECTIONS UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,601,067 to Hiyoshi ("*Hiyoshi*") in view of Signore et al. "Using Procedural Patterns in Abstracting Relational Schemata" ("*Signore*"). In view of the above amendments, this rejection is respectfully traversed. Support for the above amendments can be found throughout the specification, and particularly on page 14, line 14 – page 15, line 3.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d



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781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

*Hiyoshi* recites a sort/merge processor 10 for extracting records from a group of input files according to a record extraction criterion, reformatting the extracted records according to record reformatting rules and sorting or merging the extracted and reformatted records for output to an output file. (*Col. 4, Lines 40-55*). Applicants agree with the Examiners statement on page 9 of the Office Action that states: "*Hiyoshi* does not specifically teach 'using a current user task context and content type'" to select sort keys for sorting the information items regarding the content.

The Office Action relies on *Signore* as teaching such a feature. *Signore* recites a process for reverse engineering a database to reconstruct a data structure. In *Signore*, user intervention is suggested to help select a primary key from potential primary keys (identification indicators) for reconstructing the data structure when a unique primary key is not automatically detected. (*Sections 3 and 4 on Pages 129-130*). Thus, the primary key is selected by the user in real-time based on identification indicators being currently viewed by the user.

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There is no teaching or suggestion in *Signore* of a mechanism for deriving sort keys “from predetermined user sorting preferences for a current user task context and a content type for the information items” (*emphasis added*), as now recited in independent Claims 1, 6, 11 and 16. In fact, *Signore* teaches away from the claimed invention by requiring the user intervention to be performed in real-time based on currently viewable information. The user would not be able to select the primary key without first observing the identification indicators extracted from the information. Thus, there is no motivation to modify *Signore* to select the primary key based on predetermined user preferences.

For these reasons, the proposed *Hiyoshi-Signore* combination does not disclose, teach, or suggest the Applicant's invention as recited in Claims 1, 6, 11 and 16 (and their dependent claims). Accordingly, the Applicants respectfully request withdrawal of the § 103 rejections and full allowance of Claims 1, 3-6, 8-11, 13-16 and 18-20. Claims 2, 7, 12 and 17 have been canceled, thus rendering the rejection of these claims moot.

#### VI. NEW CLAIMS

The Applicants have added new Claims 21-24. The Applicants respectfully submit that no new matter has been added. Support for new Claims 21-24 can be found throughout the specification, and particularly on page 9, line 17 – page 10, line 1; page 11, lines 12-16; and page 12, line 1 – page 13, line 19. The Applicants respectfully request entry and full allowance of Claims 21-24.

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As a result of the foregoing, the Applicant asserts that the remaining claims in the application are in condition for allowance and respectfully requests an early allowance of such claims.

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**SUMMARY**


For the reasons given above, the Applicant respectfully requests reconsideration and allowance of all pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at [wmunck@davismunck.com](mailto:wmunck@davismunck.com).

Although Applicants do not believe any fees are due at this time due to the timely filing of the previously submitted, albeit inadvertently filed, response on August 6, 2004, the Commissioner is hereby authorized to charge any fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

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William A. Munck  
Registration No. 39,308

P.O. Drawer 800889  
Dallas, Texas 75380  
Phone: (972) 628-3600  
Fax: (972) 628-3616  
E-mail: [wmunck@davismunck.com](mailto:wmunck@davismunck.com)